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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/173,134	10/15/1998	GEORGE S. GABRIEL	364106/176	1325

7590

10/03/2005

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EXAMINER

NGUYEN, SON T

ART UNIT

PAPER NUMBER

3643

DATE MAILED: 10/03/2005

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/173,134
Filing Date: October 15, 1998
Appellant(s): GABRIEL ET AL.

Steven Pokotilow
For Appellant

EXAMINER'S ANSWER

MAILED

OCT 03 2005

GROUP 3600

This is in response to the appeal brief filed 7/21/05 appealing from the Office action
mailed 6/2/04.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4989545	Scheaffer et al.	2-1991
5894816	Coiro et al.	4-1999

Applicants' admitted prior art, specification, pages 1-3.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheaffer et al. (US 4,989,545 on form PTO-1449) in view of applicants' admitted prior art (herein AAPA).

For claim 1, Sheaffer et al. disclose a multipurpose cage level barrier rodent cage for housing multiple species of rodents, including mice or rats in a ventilated rack and cage system (as mentioned in applicants' specification on page 1) comprising a cage bottom 22 having a plurality of integral side walls 50, a floor 22 and an open top end closed off by a filter bonnet 24. In addition, Sheaffer et al.'s rack for supporting the cages comprises a ventilating system for directly providing air ventilation to and continuously removing exhaust air from the cages supported by the rack (col. 4, lines 25-39 and col. 5, lines 12-56). Sheaffer et al. are silent about the floor having a length l and a width w wherein $80 \text{ in}^2 \leq l \times w \leq 110 \text{ in}^2$. AAPA submits on page 1 of the specification that one of ordinary skill in the art would recognize the floor area of a cage for laboratory animals to be a parameter that may be varied depending on, among other things, the type and number of animals intended to be housed in order to provide the

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animals with a hygienic and humane environment. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the floor of the cage of Sheaffer with the dimension range as listed above, since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

For claim 2, again, on page 1 of the specification, AAPA submits that "ILAR guidelines set non-binding minimums for size and dimension of cages for rodents. For mice weighing more than 25 grams, a cage having a floor dimension of at least 15 square inches per mouse is required. Rats up to 400 grams in size require a cage having floor dimensions of at least 40 square inches per rat. Similar requirements are mandated for hamsters and guinea pigs by the AWA". Base on this evidence, it would have been obvious to one having ordinary skill in the art at the time the invention was made to determine a set of dimensions for the floor area of Sheaffer's cage that would result in a floor area of 80 square inches in order to provide a cage having a floor area sufficient to accommodate two rats weighing up to 400 grams each to meet ILAR guidelines and the AWA as discussed by AAPA.

Claims 3,8,9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheaffer et al. (US 4,989,545 on form PTO-1449) in view of Coiro et al. (US 5,894,816 on form PTO-1449).

For claim 3, in addition to the above, fig. 4 and col. 8, lines 57-64 of Sheaffer et al. disclose a double sided rack having a depth. However, Sheaffer are silent about the

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length of the cage being less than substantially 18 inches. Coiro et al. disclose a cage level barrier cage comprising a cage bottom having an inner length 17 at the receptacle rim of about 11.4 inches (col. 5, lines 57-59) and an outer length L6 at rim of the receptacle of 11.75 inches (col. 4, lines 57-58). Based on this, the length of Coiro et al.'s cage is consider to be less than substantially 18 inches. It follows that the length of Coiro et al.'s cage is also "less than substantially 36 inches" as claimed by applicant in claim 6. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a cage level barrier cage as taught by Coiro et al. in Sheaffer's double sided ventilated rack in order to provide a ventilated cage and rack system comprising cages having a usable floor space of 75 square inches, as taught by Coiro in col. 5, lines 60-63, to thereby accommodate up to five mice weighing 25 grams each, while retaining compatibility with existing wire bar lids and microbarrier tops as taught by Coiro in col. 3, lines 17-19.

For claim 8, please see the above paragraphs.

For claim 9, Sheaffer et al. as modified by Coiro et al. disclose the above features except a portion of the cage, when resting within the rack, extends beyond the rack. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a portion of the cage of Sheaffer et al. as modified by Coiro et al., when resting within the rack, extends beyond the rack depending on a chosen length one wishes to have (as long as it meets ILAR guidelines) because one of ordinary skill in the art would recognize the floor area of a cage for laboratory animals to be a parameter that may be varied depending on, among other things, the type and

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number of animals intended to be housed in order to provide the animals with a hygienic and humane environment.

(10) Response to Argument

Appellants argued that the Examiner has failed to present a prima facie case of obviousness.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation for floor area of a cage is as taught by AAPA (Applicant Admitted Prior Art) on page 1 of the specification that one of ordinary skill in the art would recognize the floor area of a cage for laboratory animals to be a parameter that may be varied depending on, among other things, the type and number of animals intended to be housed in order to provide the animals with a hygienic and humane environment. In addition, again, on page 1 of the specification, AAPA submits that "ILAR guidelines set non-binding minimums for size and dimension of cages for rodents. For mice weighing more than 25 grams, a cage having a floor dimension of at least 15 square inches per mouse is required. Rats up to 400 grams in size require a cage having floor dimensions of at least 40 square inches per rat. Similar requirements are mandated for hamsters and guinea pigs by the

AWA". Base on this evidence, it would have been obvious to one having ordinary skill in the art at the time the invention was made to determine a set of dimensions for the floor area of Sheaffer's cage that would result in a floor area of 80 square inches in order to provide a cage having a floor area sufficient to accommodate two rats weighing up to 400 grams each to meet ILAR guidelines and the AWA as discussed by AAPA.

Furthermore, the motivation for utilizing a cage level barrier cage as taught by Coiro et al. would be to provide a ventilated cage and rack system comprising cages having a usable floor space of 75 square inches, as taught by Coiro in col. 5, lines 60-63, to thereby accommodate up to five mice weighing 25 grams each, while retaining compatibility with existing wire bar lids and microbarrier tops as taught by Coiro in col. 3, lines 17-19.

And finally, the motivation for having a portion of the cage of Sheaffer et al. as modified by Coiro et al., when resting within the rack, extends beyond the rack would depends on a chosen length one wishes to have (as long as it meets ILAR guidelines) because one of ordinary skill in the art would recognize the floor area of a cage for laboratory animals to be a parameter that may be varied depending on, among other things, the type and number of animals intended to be housed in order to provide the animals with a hygienic and humane environment. Note that Coiro teaches the dimension range as claimed by Appellants in claim 8.

Appellants argued that Appellants have discovered the source of a problem/long-felt need and failure of others, thus, overcomes obviousness rejections.

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The Declaration under 37 CFR 1.132 filed 7/21/05 is insufficient to overcome the rejection of claims 1-3,8,9 based upon the rejection under 35 USC § 103 as set forth in the last Office action or in the above under "Grounds of Rejection" because it states that the claimed subject matter solved a problem that was long standing in the art.

However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04. Recognizing a problem and discovering the cause of the problem without proof that the problem was a long standing one in the art and that others have tried to work on the problem but were not successful in solving the problem do not overcome an obviousness rejections.

Regarding the Declaration of Nick Guise, the Declaration has been acknowledged and considered by the Examiner. However, the Examiner believes that the Declaration does not provide sufficient evidence as required for source of a problem/long-felt need and failure of others. The Declaration merely states why Wyeth Research, which employs Mr. Guise, purchase the One Cage System from Lab Products (the Appellants), which appears to be a personal preference and not a long standing problem in the art. In addition, the space problem appears to be solve by moving to a larger facility and not by buying the One Cage System to save space because the Declaration states that Wyeth Research moved from a 5,000 square foot facility to a new 17,000 square foot facility. It is uncertain what percentage of this new

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facility is designated for cage system, thus, it would be hard to draw a conclusion that the problem lies in the fact that the cage system takes up too much space, hence, the One Cage System is preferred because it saves space, thus, solving a standing problem of space availability. Furthermore, the Declaration moves on to state why Wyeth purchase the One Cage System (see numeral 9 of the Declaration), which, again, appears to be a personal preference based on the Company's needs and criteria and not a long standing problem in the art.

Regarding the Declaration of Neil Campbell, the Declaration has been acknowledged and considered by the Examiner. However, the Examiner believes that the Declaration does not provide sufficient evidence as required for source of a problem/long-felt need and failure of others. In the Declaration, Mr. Campbell states that the cage and rack systems described in Sheaffer et al. were each directed to a single animal type or size, and there is not a single word in Sheaffer that would suggest a cage wherein the overall dimensions of the cage are designed to simultaneously meet ILAR guidelines for more than one animal species. The Examiner cannot find anywhere in the Sheaffer patent stating that it is only for a single animal type as alleged by Appellants. As a matter of fact, the abstract and col. 7, lines 32-34, of Sheaffer states more than one animal being in the cage 20 and not only a single animal type or size. To a person of ordinary skill in the art, he/she can place any type and number of rodents in the cage of Sheaffer as long as the living condition/dimension meets ILAR guidelines for humane treatment of the animals. Further into the Declaration, Mr. Campbell states that most cage level barrier and systems are intended for use with a single, specific rodent

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type, and each is sized to house a single specific rodent type or a plurality of that specific rodent type (page 5, number 4). This, the Examiner believes, is intended use of a device. Whether one puts one or two of different rodent type in the cage of Sheaffer is of intended use as long as the cage can hold more than one rodents, which the cage of Sheaffer can, and that ILAR guidelines are followed for humane treatment of the rodents. In conclusion, the Examiner believes that Appellants really did not solved any problem long standing in the art because, clearly, Sheaffer already teaches having more than one rodents, regardless of type, in the cage as long as it is humane; thus, there is not a problem as stated by Appellants. In addition, Coiro patent teaches the dimensioned as claimed (see claim 8), thus, there not a problem to solve by Appellants since Coiro already solved it.

Appellants argued that Appellants have provided evidence of commercial success to overcome the obviousness rejections.

Evidence of commercial success has been acknowledged but it is not found persuasive.

Regarding the Declaration of Betty Fatzie, the Examiner believes that the Declaration does not provide sufficient evidence as required for Commercial Success (MPEP Section 716.03 (a)-(b)). Firstly, the dollar values given by Betty Fatzie (paragraph 12 in the Declaration of Betty Fatzie) are not evidence for commercial success because these values could reflect heavy promotion or advertising, shift in advertising, consumption by purchasers (such as Dietrich Crase who has been purchasing lab cages from LPI at least before 1999, see Declaration of Dietrich Crase,

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paragraph 4) normally tied to assignee or applicant, or other business events.

Secondly, the inventor's or assignee's opinion as to the purchaser's reason for buying the product (such as the One Cage System being cheaper, thus saving money for purchasers) is insufficient to demonstrate a nexus between the sales and the claimed invention. Thirdly, conclusory statements or opinions, such as stated in paragraph 10 of the Declaration of Betty Fatzie, of increased sales were due to the merits of the claimed invention are entitled to little weight. Fourthly, paragraphs 13 & 14 of the Declaration appear to be an opinion of what Betty Fatzie believes how the One Cage System has satisfied her customers and not evidence of commercial success. Lastly, paragraph 15 merely states a purchaser's satisfaction with the One Cage System, of which said purchaser (Advance Medicine) normally tied to assignee or applicant since 1999.

Regarding the Declaration of Dietrich Crase, the Examiner believes that the Declaration does not provide sufficient evidence as required for Commercial Success (MPEP Section 716.03 (a)-(b)) and/or Long-felt need (MPEP Section 716.04).

Paragraphs 4,6,11 of the Declaration states that by using the One Cage System, inventories are reduce because Mr. Crase no longer have multiple cages for different animals. However, this statement is not evidence under Long-felt Need because although the claimed invention achieved the desirable result of reducing inventories, there is no evidence of any prior unsuccessful attempts to do so. In addition, no evidence has been provided that shows the long-felt need must not have been satisfied by another before the invention by applicant. Furthermore, paragraph 10 of the Declaration states that the One Cage System is cost savings for the purchasers, which

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said cost saving is not an evidence for long-felt need because it is not a problem that is existed in the art for a long period of time without a solution. Moreover, preferring the One Cage System over another brand as stated in number 11 would be of personal preference for the satisfaction of the product and not whether the product is a long felt need or commercial success, thus, does not overcome obviousness rejections.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Son T. Nguyen



Primary Examiner

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Conferees:

Peter Poon



Robert Swiatek

